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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#21 Appeal AFF
PAT-009B
Brief
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In re the Application of:

Ronald A. Katz, et al.

Serial No.: 09/505,619

Filed: February 16, 2000

For: METHODS AND APPARATUS
FOR INTELLIGENT, PURPOSE-
BASED SELECTION
OF GOODS AND SERVICES IN
TELEPHONIC AND
ELECTRONIC COMMERCE
(as amended)

Group Art Unit: 3625

Examiner: Garg, Yogesh C.

Attorney Docket No.: PAT-009B

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir or Madam:

The appellants filed a Notice of Appeal in the above-identified application on 9 February 2004, and submit this Appeal Brief under 37 CFR 1.192 (hereinafter "Rule 192"), along with a request for a one-month extension of time under 37 CFR 1.136(a). Accordingly, the appellants respectfully submit that this Appeal Brief is timely filed under 37 CFR 1.191 and meets the substantive requirements of Rule 192. The appellants request entry, consideration, and favorable action on this appeal and brief at the Office's earliest convenience.

In accordance with Rule 1.192(c), the appellants present the following items under the headings prescribed therein.

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being sent via first class United States mail postage prepaid on the date shown below to Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

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Real Party in Interest

West Corporation of Omaha, NE owns the subject application.

Related Appeals and Interferences

Neither the assignee nor the appellants are aware of any other appeals or interferences
5 that would bear on the Board's decision in this appeal.

Status of Claims

On 9 February 2004, the appellants filed a Notice of Appeal from the final rejections of
pending claims 172-219 as stated in the Official Action mailed on 6 October 2003 (hereinafter
the "Final Action"). Claims 1-171 were previously cancelled, and claims 220-272 were
10 previously withdrawn from consideration.

Status of Amendments

On 8 December 2003, the appellants filed a response after the final rejection, but this
response contained only arguments and no amendments to the claims. Accordingly, no proposed
claim amendments have been denied entry.

15 Summary of Invention

To summarize certain aspects of the instant invention, the appellants submit the following
excerpt from column 19, lines 24-58 of issued United States Patent No. 6,055,513, which is the
parent case of the application currently under appeal. This passage reads as follows, in pertinent
part:

20 "As shown in Fig. 4, a user interacts with the system via contact block 140 such as by
having a primary transaction comprising an Internet order transaction being entered or
effectuated by a user at a personal computer (PC) terminal. During the course of the primary
transaction, processing step 142 serves to receive data at a address website and process the
primary transaction. That transaction may be optionally consummated or not as suits the overall
25 purpose of the transaction. By way of example, if the upsell serves to obviate the purpose for the
primary transaction, such as when the primary transaction is for customer service or repair, and
the upsell is successful in providing the customer with a new product in replacement thereof,
then the primary transaction need not be consummated in the manner contemplated by the user at

the point of initial contact 140. Continuing with the flow of the program, at analysis block 140, the various inputs for use by the analysis system are collected, and subsequently analyzed. ... Upon completion of the analysis at analysis block 144, the output of the analysis block 144 is provided to the user through action block 148. The upsell data may then be displayed on the caller's PC as an additional offer, or in lieu of the primary transaction."

The only pending independent claim, claim 172 recites a method for providing offers of an item, in the form of a good or a service, to prospective customers as users (e.g., reference 74 in Figure 3) of a system, utilizing an electronic communications device (e.g., reference 88 in Figure 3). As recited in claim 172, the method comprises establishing a communication via the electronic communications device between the user and the system to conduct a primary transaction (e.g., reference 238 in Figure 7) for a first good or service. The method then obtains primary transaction data (e.g., reference 300 in Figure 6) relating to the primary transaction, with the primary transaction data including at least the identity of the prospective customer and the purpose of the primary transaction. The method then utilizes the identity of the prospective customer to obtain at least a second data element relating to the prospective customer (e.g., data obtained from one or more of the databases 246, 248, or 250 shown in Figure 7). The method then utilizes the primary transaction data, including the purpose of the primary transaction, along with the second data element to determine at least one upsell item to offer the prospective customer (e.g., block 254 in Figure 7). The upsell item is different than the first good or service originally sought by the prospective customer. Finally, the method offers the item to the prospective customer in lieu of the first good or service sought by the prospective customer (e.g., block 260 in Figure 7).

Issues

The appellants address the following issues in the arguments presented below, mainly pertaining to whether the Final Action states a *prima facie* case of obviousness as applied to the various claims discussed below.

As to the claims in Group I:

1. Whether Walker and Kenney, even if properly combined under § 103(a), disclose or suggest all elements recited in independent claim 172?

A. Whether Walker discloses or suggests the claimed limitations of capturing or analyzing data that includes the purpose for which a given primary transaction is conducted?

5 B. Whether Walker discloses or suggests the claimed limitations of offering an additional item in lieu of a first good or service sought in the given primary transaction?

2. Whether Walker provides any suggestion or motivation to combine its teachings with Kenney to meet claim 172, or instead teaches away from claim 172?

10 As to the claims in Group II:

In addition to the above issues presented by the claims in Group I, the claims in Group II present the further issues of whether Walker provides any suggestion or motivation to analyze and process primary transactions that are not fully consummated, various examples of which are recited in the claims assigned to
15 Group II, or instead teaches away from the claims in Group II?

As to the claims in Group III:

In addition to the above issues presented by the claims in Group I, the claim in Group III present the further issues of whether Walker provides any suggestion or motivation to offer additional items in real time with a primary transaction for a
20 first item, as recited in claim 195, or instead teaches away from claim 195?

As to the claims in Group IV:

1. In addition to the above issues presented by the claims in Group I, the claims in Group IV present the further issue of whether Official Notice is properly taken of utilizing the time at which a given primary transaction occurred in
25 selecting the additional item to offer?

2. In addition to the above issues presented by the claims in Group I, the claims in Group IV present the further issues of, even assuming that Official Notice is properly taken, whether Walker provides any suggestion or motivation

to utilize the time at which a given primary transaction occurred in selecting the additional item to offer?

As to the claims in Group V:

5 In addition to the above issues presented by the claims in Group I, the claims in Group V present the further issue of whether Walker provides any suggestion or motivation to analyze a geographic identifier associated with a first transaction when selecting an additional item to offer a user?

As to the claims in Group VI:

10 1. In addition to the above issues presented by the claims in Group I, the claims in Group VI present the further issue of whether Official Notice is properly taken of using data related to surveys or registrations as input in selecting the additional item to offer?

15 2. In addition to the above issues presented by the claims in Group I, the claims in Group VI present the further issue of, even assuming that Official Notice is properly taken, whether Walker provides any suggestion or motivation to use data related to surveys or registrations as input in selecting the additional item to offer?

Grouping of Claims

The appellants group the rejected claims as follows:

20 Group I: claims 172-178, 180, 182-183, 189-194, 200-207, and 212-219;

Group II: claims 179, 181, and 184-188;

Group III: claim 195;

Group IV: claims 189-194;

Group V: claims 196-199; and

25 Group VI: claims 208-211.

The claims within each of the above groups stand or fall together. In the arguments below, the appellants present reasons why each group of claims is separately patentable.

ArgumentGroup I

MPEP § 2143 states the basic requirements for a *prima facie* case of obviousness under § 103(a) as follows:

5 “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

10 The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

 Regarding the rejections of the Group I claims, the appellants respectfully submit that the § 103(a) rejections of these claims as being unpatentable over Walker and Kenney fail to state a *prima facie* case of obviousness for at least two reasons. First, the proposed combination of Walker and Kenney, even assuming such combination is proper, fails to teach or suggest at least two features recited in independent claim 172, as required by MPEP § 2143 quoted above. Second, Walker teaches away from the invention recited in independent claim 172, and therefore provides no suggestion or motivation to those skilled in the art to combine it with Kenney, or to any other art, to meet independent claim 172.

1. Walker and Kenney fail to meet all elements recited in claim 172 as required by MPEP § 2143.

25 First, even assuming only for the sake of discussion that Walker and Kenney are properly combined under § 103, their combined teachings fail to disclose or suggest all of the elements recited in independent claim 172 as required by MPEP § 2143. Thus, the rejection of claims 172-183, 195, 200-207, 212-214, and 219 fails to state a *prima facie* case of obviousness on at least this basis.

 In providing even more detailed guidance on this issue, MPEP § 2143.03, entitled “All Claim Limitations Must Be Taught or Suggested”, states:

“To establish prima facie obviousness of a claimed invention, *all the claim limitations* must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).” (emphasis added).

The appellants submit that the combined teachings of Walker and Kenney fail to disclose or suggest at least two elements recited in independent claim 172. Each of these missing elements is addressed separately in the following two arguments. As to both elements, Kenney fails to provide the teaching missing from Walker necessary to meet independent claim 172.

A. Walker neither discloses nor suggests the capture or analysis of primary transaction data that includes the purpose for which the primary transaction is conducted.

The appellants respectfully submit that Walker and Kenney fail to teach or suggest at least the following two features recited in independent claim 172. For convenience in discussion, the appellants reproduce here the second and fourth sub-paragraph of claim 172, with emphasis added:

“obtaining primary transaction data ... including ... *the purpose of the primary transaction*”,

“utilizing at least in part the primary transaction data including *the purpose of the primary transaction...*”,

As noted in Paragraph 3 of the Final Action, while every purchaser may inherently or implicitly have some subjective reason or purpose for conducting a given transaction, that observation alone is far from sufficient to teach or suggest the features emphasized in the claim language above. To meet this claim limitation, it is not sufficient that a user may have some mental, subjective purpose for conducting the transaction. Instead, the cited art must disclose obtaining and utilizing data relating to this purpose. The appellants respectfully submit that Walker neither teaches nor suggests obtaining data related to a primary transaction that includes the purpose for which the primary transaction was conducted. Further, Walker neither teaches nor suggests utilizing this data representing the purpose for which the primary transaction was conducted to determine the upsell item to offer to the user. For at least this reason, Walker fails

to support a *prima facie* case of obviousness under § 103(a), and Kenney fails to provide the teaching missing from Walker.

Turning to Walker in more detail, Walker provides a central controller used by, for example, a credit card account issuer that regularly receives certain information relating to consummated account transactions and periodically generates account billing statements therefrom. The Walker system then uses those account billing statements to offer supplementary product sales to the account holders. See, e.g., Walker Abstract and Walker, column 1, lines 5-10. Walker's Figure 3 illustrates various upsell conditions 44, which appear to be the various criteria that Walker examines to determine an upsell item to offer a given account holder. Walker further expressly discusses these upsell conditions in at least the following portions of the written description:

column 2, line 59-60: "The offered product is determined from previous purchases that are recorded on the billing statement ...";

column 4, line 55 through column 5, line 7, and in column 7, lines 31 through 44, providing further examples of "upsell offer conditions", more particularly:

column 4, lines 44-56; column 7, lines 35-36: "... purchase of a predefined product ...";

column 4, lines 60-61; column 7, lines 37-38: "... purchase price is for more than a predefined price ...";

column 4, lines 61-62; column 7, lines 38-39: "... purchase is for a price within a predefined price range ...";

column 4, line 63; column 7, line 40: "... a predefined number of purchases have been made ...";

column 4, lines 64-65; column 7, line 41-43: "... a predetermined merchant has not been visited by the account holder ...",

column 5, lines 1-2: "... a predetermined type of merchant has been visited by the account holder ..."

column 7, line 44: "... any combination thereof."

Contrary to the rejection of claim 172 as stated in paragraph 5 of the Final Action, these various examples of Walker's "upsell offer conditions" do not disclose or suggest considering or analyzing the purposes for which the account holder conducted the various transactions appearing on the billing statement. Walker also fails to disclose or suggest using those purposes to determine an upsell transaction to offer on the billing statement, as recited in claim 172 and emphasized in the excerpts provided above.

Referring specifically to the upsell conditions 44 shown in Walker's Figure 3 and the related discussion cited above, one characteristic common to all of these upsell conditions is that the data necessary to evaluate these upsell conditions were conventionally available to and routinely stored and maintained by credit card transaction processors and account issuers, independently of Walker's disclosed invention. These data include, for example, item numbers, purchase prices for specific items, merchant identifiers, or dates of transactions. Thus, Walker capitalizes on conventional data already received and processed by credit card issuers and transaction processors. Walker provides no evidence that credit card account issuers would have any interest in the purposes underlying a given buyer's participation in a given transaction, or would have any reason to capture or process such data. Thus, Walker fails to suggest to those skilled in the art the desirability of modifying the operations of a transaction processor or account issuer to assume the additional burden of receiving and processing such data, in addition to the conventional transaction data it already processes. The only suggestion or motivation for obtaining and processing such data comes from the appellants' own specification, contradicting MPEP § 2143 as quoted above.

Therefore, on at least this independent basis, the appellants respectfully submit that the § 103 rejection of claims 172, and all claims depending therefrom, based at least in part on Walker and Kenney fails to state a *prima facie* case of obviousness. Thus, these rejections should be reconsidered and withdrawn because the cited art fails to teach or suggest every feature recited in independent claim 172, namely the analysis of primary transaction data that includes a purpose for which the primary transaction was conducted.

B. Walker neither teaches nor suggests offers of an upsell item in lieu of the first good or service.

Secondly, as to pending independent claim 172, and all claims depending therefrom, the appellants further respectfully submit that Walker fails to teach or suggest:

“offering the item to the prospective customer *in lieu of the first good or service*”,
as recited in the fifth sub-paragraph of claim 172 (emphasis added).

5 The paragraph bridging pages 5 and 6 of the Final Action asserts that Walker discloses an upsell transaction that is a replacement transaction for the good purchased or to be purchased in the primary transaction, and that Walker discloses offering the upsell transaction in lieu of the first good or service. This paragraph of the Final Action cites several examples from Walker of “upsell” items that are “complementary” or “related” to previously purchased products. For
10 example, one of Walker’s examples includes offering warranty coverage for a previously purchased television set. However, in this example from Walker, the warranty is offered in addition to the previously purchased television set, not in lieu of the television set, as recited in claim 172. The American Heritage Dictionary defines “in lieu of” as “in place of”, or “instead of”. In light of this definition the appellants respectfully submit that none of the examples from
15 Walker cited on page 6 of the Final Action teach or suggest offering upsell items in lieu of, or as a replacement to, the first good or service.

 Aside from the Walker examples cited in the Final Action, the appellants submit that Walker discloses additional examples of upsell items that may be “complementary” or “supplementary” to the products involved in the first transaction, but are not “replacement” or
20 “substitute” upsell items offered truly in lieu of the first good or service. Turning to Walker in more detail, it compares the first transaction to the “upsell” item in at least the following places:

Column 1, line 9: “... supplementary product sales.”;

Column 1, line 55: “... additional sales.”;

Column 2, lines 57-58: “... products complementary to previously-purchased
25 products...”;

Column 3, line 1: “... complementary product ...”;

Column 3, line 8: “... complementary product ...”; and

Column 3, line 58: “... additional product ...”.

Given these express teachings from Walker, the appellants must respectfully traverse the assertion in the Official Action that Walker discloses upsell items offered in lieu of or as replacements for the first good or service, because neither complementary, supplementary, nor additional products (as expressly taught by Walker) teach or suggest an upsell item that is offered in lieu of or as a replacement to the primary good or service, as recited in the appellants' independent claim 172. Further, while Walker recites in column 9, lines 35-42 the typical boilerplate language regarding various other embodiments of the invention, this rote recitation is not sufficient to contradict Walker's express teachings or to extend those express teachings to meet appellants' claimed invention.

For at least the foregoing reasons, the appellants submit that the rejections of claims 172 and all claims depending therefrom under § 103(a) fail to state *prima facie* cases of obviousness because the cited portions of Walker and Kenney fail to teach or suggest all features recited in independent claim 172, as required by the MPEP. On at least this independent basis, the appellants request reconsideration and withdrawal of the § 103 rejections of these claims.

2. Walker teaches away from claim 172 and thus provides no suggestion or motivation to combine its teachings with Kenney to meet claim 172.

As a second basis for traversing the § 103 rejection of the claims in Group I, the appellants respectfully submit that the stated rejections fail to define a *prima facie* case of obviousness under § 103(a) because Walker teaches away from claim 172, and thus provides no motivation or suggestion to those skilled in the art to look to Kenney, or to other art, to supply the teachings missing from Walker to meet the claim 172.

The United States Supreme Court long ago recognized that where the claimed invention proceeds contrary to the teachings of the prior art, the prior art is said to "teach away" from the claimed invention, and that this is strong evidence of non-obviousness of the claimed invention. *U.S. v. Adams*, 383 U.S. 39, 148 USPQ 479 (1966). In later cases, the Court of Appeals for the Federal Circuit has stated that in short, teaching away is the antitheses of the art suggesting that the person of ordinary skill go in the claimed direction. *In re Fine*, 873 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988). The Federal Circuit has gone even further to hold that where the prior art teaches away from the claimed invention, no *prima facie* case of obviousness exists. *In re*

Hedges, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986), and *In re Nielson*, 816 F.2d 1567, 2 USPQ 2d 1525 (Fed. Cir. 1987).

The appellants reproduce the following pertinent language from claim 172 for ease of discussion, with emphasis added:

5 “offering the item to the prospective customer *in lieu of* the first good or service.”

Applying the above Supreme Court doctrine to the case at hand, the appellants respectfully submit that Walker teaches away from the invention as recited in claim 172, and all claims depending therefrom. More specifically, Walker contemplates offers for products that are offered as supplements, complements, or additions to a first transaction that has already been
10 fully completed or consummated. Thus, Walker’s first transaction is fully consummated at the time the additional item is later offered via the customer’s billing statement. Were this first transaction not fully consummated, it would not be posted to the billing statement, since credit card issuers typically do not list non-consummated transactions on billing statements sent to account holders.

15 Reviewing Walker’s teachings in more detail, it uses the actual credit card charge data resulting from the consummated first transaction to determine a possible additional product offer, as shown by Walker’s examples of “upsell offer conditions” discussed above. See, e.g., Figure 7 of Walker and related discussion in the Walker specification. In Walker, the only reason this charge data exists (see transaction record 60) is because the first transaction has already been
20 consummated when the potential additional product offers (see upsell record 30) are determined.

In contrast to Walker’s offer of items that supplement, complement, or add to items obtained in a previous, consummated first transaction, claim 172 recites an upsell transaction that is offered in lieu of or as a replacement to the primary transaction. Thus, the upsell item recited in claim 172 supplants the first transaction, rather than supplementing or complementing it.
25 Further examples of Walker’s offered items include incentives or discounts towards a future purchase, e.g. a "discounts on predetermined products" (Walker, column 2, line 11), or on a companion product, e.g., "products complementary to previously purchase [sic] products" (Walker, column 2, line 12-13). However, none of the Walker examples discussed herein teach or suggest upsell items that are offered in lieu of the primary or base transaction, as recited by
30 claim 172. In short, Walker teaches a consummated first transaction, while the appellants claim

a non-consummated first transaction. Walker thus provides no suggestion or motivation to those skilled in the art to contradict Walker's express teachings by looking to Kenney, or to any other art, to obtain a system that features non-consummated first transactions. This is the essence of the "teaching away" doctrine discussed above. Any suggestion or motivation to modify Walker as proposed in the rejection of claim 172 comes only from the appellants' specification, contradicting MPEP § 2143 as quoted above.

On at least this independent basis, the appellants respectfully submit that the § 103 rejection of claims 172, and all claims depending therefrom, based at least in part on Walker and Kenney fails to state *a prima facie* case of obviousness under § 103(a), and should be reconsidered and withdrawn because Walker teaches away from the claimed subject matter.

Group II

Regarding the claims in Group II, in addition to the arguments stated above relating to the claims in Group I, the appellants respectfully submit that the § 103(a) rejections of these claims fail to state a *prima facie* case of obviousness because Walker and Kenney provide no suggestion or motivation to combine their teachings as stated in the rejections of claims 179, 181, and 184-188. Alternatively, Walker teaches away from the rejected Group II claims.

Turning first to Walker, read fairly as a whole, it discloses a central controller deployed by an entity that generates billing statements, such as a credit card issuer. See, e.g., Abstract of Walker. In this context, the transactions typically listed on such billing statements include completed purchase transactions and payments previously made by the account holder. The appellants thus agree with the assessments on pages 7 and 11 of the Final Action that Walker and Kenney do not disclose primary transactions that are not consummated or that are conducted for purposes such as inventory checks or status, order fulfillment, or informational inquiries, as recited in the rejected claims 179, 181, and 184-188. However, the appellants respectfully submit that Walker provides no suggestion or motivation to extend its concept of “primary transactions” in view of Kenney, or any other art, to include matters such as inventory checks, status inquiries, or order fulfillment inquiries as proposed in the rejections of these claims. Instead, the appellants submit that the cited art provides at least five disincentives to modify Walker to process these unconsummated matters, and instead teaches away from the rejected claims.

First, extending Walker’s “primary transactions” as proposed in the Action would result in the transaction processors and/or account issuers storing, accessing, and/or analyzing data regarding unconsummated matters such as status/inventory checks, inquiries, or other such matters. Clearly, those skilled in the art would understand that this data would be quite voluminous and would impose significant storage burdens on the transaction processors or account issuers, all of which are disincentives to the proposed modification of Walker.

Second, extending Walker’s teachings to include “primary transactions” such as these checks and inquiries from account holders would result in billing statements that list such checks and inquiries. Account holders and merchants, such as those described by Walker and as discussed above, are primarily interested in those purchase transactions that are fully

consummated and completed by the purchaser, as well as in payments that are tendered by the account holder and acknowledged by the account issuer. These items present the actual pecuniary value for which the account holder is billed and for which the account holder pays. Any other information appearing on statements would be recognized by those skilled in the art as mere surplusage. If Walker's "primary transactions" were extended to include matters such as checks, inquiries, or the other subject matter recited in the rejected claims, and these checks and inquiries were reported on the account statements like Walker's other "primary transactions", this would only burden the account holders with additional superfluous information, in exchange for little if any corresponding benefit. Clearly, those skilled in the art would recognize these disincentives of modifying Walker as proposed, whether in view of Kenney or any other art.

Third, modifying Walker to generate upsells based on checks, inquiries, or other matters recited in the rejected claims, or to list such matters on the account statements, would impose significant processing burden on the merchants and account issuers in the Walker system, with little perceptible benefit to offset those burdens. More particularly, the Walker merchant would have to report these matters to the billing entity that generates the account statements, as well as to any transaction processors operating therebetween. Further, the billing entity would have to store, sort, and organize this data to generate the upsells therefrom. Regardless of whether these matters are ultimately printed on the account statements, the financial benefit accruing to the Walker account issuer, merchants, or transaction processors attributable to tracking, analyzing, and reporting such matters is unclear, absent the appellants' teachings. Furthermore, as discussed above, listing such matters on the account holder's statement would merely distract or irritate the account holder when reviewing his or her account statement, because, as discussed above, the account holder is primarily interested in what he/she bought and whether his/her last payment was acknowledged and credited to the account. Thus, Walker provides no motivation or suggestion to combine or modify its teaching in view of Kenney, the Official Notice, or any other art, to analyze or list "primary transactions" taking any of the forms claimed by appellants in claims 184-188. Any suggestion or motivation to do so comes only from the appellants' specification, contradicting MPEP § 2143 as quoted above.

Fourth, modifying Walker as proposed in the rejections of these claims would result in a system that could offer Walker's "complementary" or "additional" items, as discussed above, to the account holder, when the account holder may have merely inquired about, but not actually

purchased, a given primary item. In the context of Walker's teachings as a whole, this could lead to odd results in some circumstances. Without augmenting Walker with additional logic, Walker modified as proposed in the rejections might offer the account holder a warranty for a television set about which the account holder merely asked or inquired, but which the account holder never actually purchased. The burden of adding logic to Walker to detect and avoid this anomalous situation would, if anything, discourage those skilled in the art from modifying Walker as proposed in the rejections.

Fifth, Walker clearly does not list non-consummated or non-purchase transactions on its account statements. Further, the record is silent as to how exactly Walker could do so, even if adequate motivation were found outside the appellants' own disclosure. Credit card issuers or other similarly-situated entities, as such are taught by Walker, do not typically have access to data representing non-consummated transactions, simply because a consumer does not generally provide credit card numbers when performing these types of non-consummated or non-purchase transactions. Therefore, the substantial effort required to modify Walker, which teaches processing credit card transaction data, to somehow capture data representing these non-consummated or non-purchase transactions and process these data as inputs to an upsell determination further reinforces the appellants' contentions that Walker provides no suggestion or motivation to modify it as proposed in the Final Action, and instead teaches away from the proposed modifications.

For at least the above reasons, Walker provides no suggestion or motivation to those skilled in the art to modify it in view of Kenney as proposed in the rejections, and would instead recognize the disadvantages or disincentives of so modifying Walker. The incentive to modify Walker as proposed in the rejections comes, if at all, only from the appellants' specification. Accordingly, the appellants respectfully submit that the rejections of claims 184-188, 179, and 181 fail to state *prima facie* cases of obviousness under § 103(a), and request reconsideration and withdrawal of these rejections of these claims.

Group III

Regarding the Group III claim (claim 195), in addition to the arguments stated above relating to the claims in Group I, the appellants respectfully submit that the rejection of claim 195 fails to state a *prima facie* case of obviousness because Walker and Kenney are not properly combined under § 103(a).

Claim 195 is reproduced here for convenience, with pertinent portions emphasized:

195. (previously presented) The method of claim 172 wherein offering the item to the prospective customer includes offering the item to the prospective customer *in real time* with the primary transaction.

Providing more detailed guidance to the matter, MPEP § 2143 further describes situations where the proposed modification or combination would change the principle of operation of the prior art references as follows:

“THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.” 270 F.2d at 813, 123 USPQ at 352.)”

The appellants respectfully submit that these principles, when applied to the rejection of claim 195 over Walker combined with Kenney, establish that Walker cannot properly be combined with Kenney, and thus the rejection of claim 195 fails to state a *prima facie* case of obviousness under § 103(a).

Claim 195 recites that the upsell item is offered to the prospective customer in real time with the primary transaction. On page 8, the Final Action states that Walker does not disclose

offering the item real time with the primary transaction. The appellants agree with this assessment, but further submit that Walker provides no motivation or suggestion to those skilled in the art to modify Walker, in view of Kenney or any other art, to provide such a real-time system. The appellants further submit that so modifying Walker constitutes a change in Walker's principle of operation that is impermissible under the MPEP provisions set forth above.

Walker expressly teaches that an offer for an additional item is generated and offered to the account holder via the account statement well after completion of a given initial transaction. Depending on the timing of the initial transaction relative to the account billing cycles the additional item could be offered to the account holder as long as thirty days after the initial transaction, or possibly longer. As Walker states: "During that period of time, the account holder may have reconsidered those purchases and realized that a complementary product should have been purchased as well." (Walker, column 3, lines 4-9). Thus, Walker explicitly teaches away from offering the additional item in real time with the initial transaction. Further, Walker does not disclose or suggest means for communicating with the account holder at the time of the initial transaction, or in real time with the initial transaction, as recited in claim 195. While Walker mentions an "electronic bill" in column 7, lines 50-52, it appears that, read in the context of Walker's overall teaching, such an electronic bill would still be presented to the account holder well after the primary transaction. Unlike a printed paper statement, the electronic bill would be displayed by a "computer, terminal, or similar device." Thus, the appellants submit that this mention of an "electronic bill" does not provide the teaching or suggestion necessary to meet the appellants' claim 195, but instead discloses another vehicle for presenting an account statement to the account holder at some point after one or more initial transactions occur.

Furthermore, the appellants respectfully submit that Walker, read fairly as a whole, does not disclose or suggest the desirability of a real time upsell offer, as recited in claim 195. On the contrary, Walker's fundamental principle of operation includes a substantial delay (possibly a full account billing cycle) between conducting the primary transactions that are listed on the statement and the offer of upsell items offered in connection with that statement. Walker goes even further to state that, in some circumstances, this delay may be beneficial because it may enhance the probability of the user accepting the later-offered upsell item. For example, where the user purchases an appliance and sometime thereafter is offered a service plan or warranty, the user may be more apt to accept the service plan or warranty if some time has passed. Perhaps, in

this time interval, the appliance has already malfunctioned, thereby suggesting the desirability of such plan or warranty. After using a purchased item for some period of time, the user may realize that he/she needs certain accessories to use the purchased item more effectively. These teachings from Walker further reinforce the appellants' contention that Walker teaches away
5 from real time "upsells".

Based on the foregoing, the appellants submit that Walker provides no suggestion or motivation to modify it in view of Kenney, or any other art, to offer "upsell" items in real time with an initial or primary transaction. The appellants further submit that modifying Walker as suggested in the Official Action would impermissibly change Walker's fundamental principle of
10 operation. On at least any one of these bases, the appellants respectfully submit that the § 103(a) rejection of claim 195 improperly modifies Walker and/or improperly combines Walker and Kenney, and thus fails to state a *prima facie* case of obviousness under § 103(a). The appellants thus request reconsideration and withdrawal of the § 103(a) rejection of at least claim 195.

Group IV

Claims 189-194 (Group IV) stand rejected under § 103(a) as being unpatentable over Walker in view of Kenney and further in view of Official Notice, taken as stated in the paragraph bridging pages 11 and 12 of the Final Action. In addition to the arguments stated above relating to the claims in Group I, the appellants respectfully submit that Official Notice is not properly taken of the subject matter recited in claims 189-194, as discussed in further detail below. However, even assuming for the sake of discussion that Official Notice is properly taken of this subject matter, the appellants further submit, first, that Walker provides no incentive to combine its teachings with Kenney as stated above, and, second, Walker provides no incentive to combine its teachings with the subject matter of which the Final Action takes Official Notice in rejecting these claims.

Regarding the propriety of the Official Notice, MPEP § 2144.03 governs the taking of Official Notice, and § 2144.03(E) summarizes the applicable standard as follows:

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421.

Regarding claims 189-194, Official Notice was taken of the use of time as a factor in determining the goods/services to be offered. The appellants agree with the assessment in the Final Action that Walker does not disclose utilizing time as a factor in determining offers. However, given the difference between the type of upsell offer conditions taught by Walker and the subject matter of which Official Notice is taken, the appellants respectfully submit that the Official Notice taken as to these claims is not the type of insubstantial "gap filling" permitted under MPEP § 2144.03. In effect, the Official Notice as taken in the Final Action is attempting to "gap fill" away from the cited art, which is clearly impermissible under the MPEP.

As discussed above, Walker offers additional items to account holders using the account holder's credit card statement, and selects these additional items using data that is conventionally available to credit card transaction processors and card issuers. As acknowledged in the Final

Action, Walker does not disclose using the time at which the initial transaction occurs as an input into the item selection process, largely because conventional credit card issuers and transaction processors have no interest or motivation to maintain and track such data. These issuers and processors typically track the dates on which a given transaction occurs for reporting purposes, but the time at which the transaction occurs is of no particular relevance or importance to conventional issuers or processors. In light of these comments, the appellants submit that this gap between the cited art of record and the claimed subject matter is too substantial to be filled by Official Notice as taken in the Final Action. The appellants thus request that the Office cite documentary evidence to support the use of Official Notice to reject claims 189-194, or in the alternative, withdraw the rejections of claim 189-194, to the extent that those rejections are supported by the Official Notice as stated in the Final Action.

Even assuming for the sake of discussion that Official Notice is properly taken of the subject matter recited in claims 189-194, the above comments regarding the propriety of the Official Notice also support a contention that the § 103(a) rejection of claims 189-194 based in part on the Official Notice fails to state a *prima facie* case of obviousness, apart from whether the Official Notice is properly taken. More particularly, Walker provides no suggestion or motivation to those skilled in the art to look to Kenney, to the Official Notice, or to anywhere else to add time as an input the item selection process. Suggestion or motivation to do so comes only from the appellants' own specification. Thus, on at least this basis, the § 103(a) rejections of claims 189-194 fail to state a *prima facie* case of obviousness, and should be reconsidered and withdrawn.

Group V

Claims 196-199 stand rejected under § 103(a) as being unpatentable over Walker in view of Kenney and further in view of Pocock. The appellants agree with the assessment in paragraph 7 of the Final Action that Walker/Kenney do not disclose using geographic identifier data of the user to offer a good or service. However, in addition to the arguments stated above relating to the claims in Group I, the appellants further respectfully submit that, even assuming Walker is properly combined with Kenney, Walker provides no motivation or suggestion to those skilled in the art to combine its teachings with Pocock, or any other art, to use geographic identifier data pertaining to the user as an input to Walker's item selection process. Thus, the § 103(a) rejections of claims 196-199 fail to state a *prima facie* case of obviousness, and should be reconsidered and withdrawn.

As discussed above, Walker uses conventional credit card transaction data as inputs to its item selection process, and provides several examples of "upsell offer conditions" that are evaluated using this conventional data. Even assuming for the sake of discussion that Walker might suggest to those skilled in the art other forms of upsell offer conditions that use this conventional data, Walker does not suggest looking to Pocock or elsewhere to expand its input data to include items such as geographic identifier data. Instead, those skilled in the art would be discouraged from extending the scope of Walker's input data as proposed in the Final Action because doing so would burden credit card issuers, merchants, and transaction processors with reporting, tracking, and storing more data, specifically the data representing the geographic identifier pertaining to the user when conducting a primary transaction. Any motivation or suggestion to use this geographic identifier data as an input to an upsell item selection process comes only from the appellants' specification. On at least this basis, the appellants submit that the § 103(a) rejections of claims 196-199 fail to state a *prima facie* case of obviousness, and should be reconsidered and withdrawn.

Group VI

Claims 208-211 (Group VI) stand rejected under § 103(a) as being unpatentable over Walker in view of Kenney and further in view of Official Notice, taken as stated in the paragraph bridging pages 12 and 13 of the Final Action. In addition to the arguments stated above relating to the claims in Group I, the appellants respectfully submit that Official Notice is not properly taken of the subject matter recited in claims 208-211. However, even assuming for the sake of discussion that Official Notice is properly taken of this subject matter, the appellants further submit, first, that Walker provides no incentive to combine its teachings with Kenney as stated above with respect to claim 172, and, second, Walker provides no incentive to combine its teachings with the subject matter of which the Final Action takes Official Notice in rejecting these claims.

Regarding the propriety of taking Official Notice relating to claims 208-211, the Final Action took Official Notice of the customer pre-registering or registering to use the system, or answering survey questions or the like, with the customer inputting pertinent data during such registrations or surveys. The appellants agree with the assessment in the Final Action that neither Walker nor Kenney disclose the subject matter recited in these rejected claims. However, given the difference between the type of input data taught by Walker and the subject matter recited in the rejected claims, the appellants respectfully submit that Official Notice is not properly taken as to these rejected claims. More particularly, as discussed above, Walker operates in connection with conventional credit card accounts and conventional transaction data handled by processors and issuers. However, the systems and methods as taught by Walker attach no importance or significance to the types of data that would be captured in the registrations or surveys that are recited in the rejected claims. Instead, Walker focuses on using conventional transaction data as input to its item selection process. Given the differences between the cited art and the claimed subject matter, the appellants submit that taking Official Notice of the claimed subject matter is not the type of insubstantial “gap filling” permitted under MPEP § 2144.03, and thus request that the Office cite documentary evidence to support the use of Official Notice to reject claims 208-211. In the alternative, the appellants request withdrawal of the rejections of claims 208-211, to the extent those rejections are supported by the Official Notice as stated in the Final Action.

However, even assuming that taking Official Notice as to these claims is proper, the appellants respectfully submit that Walker provides no suggestion or motivation to combine its teachings with the subject matter of which Official Notice was taken. Instead, those skilled in the art would recognize the burdens imposed on the merchants, transaction processors, and/or account issuers associated with tracking, reporting, and maintaining additional data resulting from such registrations or surveys. These burdens would discourage those skilled in the art from modifying Walker, which operates using conventional credit card transaction data to expand Walker's input data to that recited in the rejected claims. The motivation or suggestion to do so comes only from the appellants' specification.

Appendix of Pending Claims

1-171 (canceled).

172. (previously presented) A method for providing offers of an item constituting a good or a service to prospective customers as users of the system, utilizing an electronic communications device, comprising the steps of:

establishing a communication via the electronic communications device between the user and the system for purpose of a primary transaction for a first good or service,

obtaining primary transaction data with respect to the primary transaction, including the identity of the prospective customer and of the purpose of the primary transaction,

utilizing the identity of the prospective customer to obtain at least a second data element relating to the user,

utilizing at least in part the primary transaction data including the purpose of the primary transaction and the second data element and determining at least one item for prospective upsell to the prospective customer which is different than the first good or service, and

offering the item to the prospective customer in lieu of the first good or service.

173. (original) The method of claim 172 wherein the transaction type of the primary transaction differs from the transaction type of the upsell transaction.

✓ 174. (original) The method of claim 173 wherein the primary transaction is a purchase transaction and the upsell transaction is a service transaction. (P)

175. (original) The method of claim 173 wherein the primary transaction is a service transaction and the upsell transaction is a purchase transaction. (S)

176. (original) The method of claim 172 wherein the primary transaction is a purchase transaction for a first good and the upsell transaction is a purchase transaction for a second good.

177. (original) The method of claim 173 wherein the primary transaction is a service transaction for a first good and the upsell transaction is a purchase transaction for a replacement for the first good.

178. (previously presented) The method of claim 172 wherein the primary transaction is consummated. 112^{2nd}

179. (previously presented) The method of claim 172 wherein the primary transaction is not consummated.

5 180. (previously presented) The method of claim 172 wherein the purpose of the primary transaction is a purchase transaction.

181. (previously presented) The method of claim 172 wherein the purpose of the primary transaction is an informational inquiry.

10 182. (previously presented) The method of claim 172 wherein the purpose of the primary transaction is a service transaction.

183. (previously presented) The method of claim 172 wherein the purpose of the primary transaction is a sale transaction.

184. (previously presented) The method of claim 172 wherein the purpose of the primary transaction is an inventory check.

15 185. (previously presented) The method of claim 172 wherein the purpose of the primary transaction is a status inquiry.

186. (previously presented) The method of claim 172 wherein the purpose of the primary transaction is an order fulfillment inquiry. 112^{2nd}

20 187. (previously presented) The method of claim 172 wherein the purpose of the primary transaction is a comparison shopping inquiry.

188. (previously presented) The method of claim 172 wherein the purpose of the primary transaction is a credit check. 112^{2nd}

189. (previously presented) The method of claim 172 wherein time is utilized as a factor in determining the good or service to be offered. 112^{2nd}
= perishable goods

25 190. (previously presented) The method of claim 189 wherein the time is the time of day.

191. (previously presented) The method of claim 189 wherein the time is the day of the week.

192. (previously presented) The method of claim 189 wherein the time is the day of the month.

5 193. (previously presented) The method of claim 172 wherein a factor in determining the good or service to be offered is proximity to a calendar event.

194. (previously presented) The method of claim 193 wherein the calendar event is user defined.

10 195. (previously presented) The method of claim 172 wherein offering the item to the prospective customer includes offering the item to the prospective customer in real time with the primary transaction.

196. (previously presented) The method of claim 172 wherein geographic identifier data of the user is used to determine an offer for a good or service.

15 197. (previously presented) The method of claim 196 wherein the geographic identifier data of the user is provided automatically.

198. (previously presented) The method of claim 196 wherein the geographic identifier data is provided by a carrier associated with the electronic communications device.

199. (previously presented) The method of claim 196 wherein the geographic identifier data is entered by the user.

20 200. (previously presented) The method of claim 172 wherein the identity of the good or service of the primary transaction is utilized in determining the prospective upsell.

201. (previously presented) The method of claim 172 wherein the identity of the good or service selected by the user during the primary transaction is utilized in determining the prospective upsell.

25 202. (previously presented) The method of claim 172 wherein quality of the good or service is at least one factor in determining the good or service to be offered.

203. (previously presented) The method of claim 172 wherein the offer is made orally to the prospective customer.

204. (previously presented) The method of claim 172 wherein the offer is made visually to the prospective customer.

205. (previously presented) The method of claim 204 wherein the visual offer is static.

5 206. (previously presented) The method of claim 204 wherein the visual offer is dynamic.

207. (previously presented) The method of claim 204 wherein the visual offer includes a virtual reality display.

208. (previously presented) The method of claim 172 wherein the prospective customer registers to use the system.

10 209. (previously presented) The method of claim 208 wherein the prospective customer preregisters with the system prior to use.

210. (previously presented) The method of claim 208 wherein the registration includes input of information by the prospective customer.

15 211. (previously presented) The method of claim 208 wherein the prospective customer inputs information in response to questions.

212. (previously presented) The method of claim 172 further comprising applying at least one negative rule when the at least one item for prospective upsell to the prospective customer is determined.

20 213. (previously presented) The method of claim 212 wherein the negative rule includes not offering for up sell an item determined to already be possessed by the prospective customer.

214. (previously presented) The method of claim 212 wherein the negative rule includes not offering an item determined to have been previously purchased by the prospective customer.

25 215. (previously presented) The method of claim 212 wherein the negative rule includes not offering an item determined to have been previously offered to the prospective customer, but declined.

216. (previously presented) The system of claim 172 wherein the prospective customer may interact with a live operator.

217. (previously presented) The system of claim 172 wherein the electronic communications device is a telephone.

5 218. (previously presented) The system of claim 172 wherein the electronic communications device is a videophone.

219. (previously presented) The system of claim 172 wherein the electronic communications device is a computer.

10 220. (withdrawn) A method for providing offers of an item constituting a good or a service to users of a system, utilizing an electronic communications device, comprising at least the following:

establishing a communication via the electronic communications device between a given user and the system for purpose of a primary transaction for a first good or service,

15 obtaining primary transaction data with respect to the primary transaction, including the purpose of the primary transaction,

obtaining the identity of the given user,

utilizing at least in part the primary transaction data including the purpose of the primary transaction and the identity of the user, and determining at least one item for offer to the given user, and

20 offering the item to the given user.

221. (withdrawn) The method of claim 220 wherein obtaining the identity of the user includes obtaining the given user's social security number.

25 222. (withdrawn) The system of claim 220 wherein obtaining the identity of the user includes obtaining the given user's electronic address.

223. (withdrawn) The method of claim 222 wherein obtaining the given user's electronic address includes obtaining an electronic mail (e-mail) address.

224. (withdrawn) The method of claim 222 wherein obtaining the given user's electronic address includes obtaining an internet service provider identification.

225. (withdrawn) The method of claim 220 wherein obtaining the identity of the user includes obtaining the given user's customer number.

5 226. (withdrawn) The method of claim 220 wherein obtaining the identity of the user includes obtaining the given user's electronic signature.

227. (withdrawn) The method of claim 220 wherein obtaining the identity of the user includes obtaining the given user's billing data.

10 228. (withdrawn) The method of claim 220 wherein offering the item to the given user includes offering the item to the given user in real time with the primary transaction.

229. (withdrawn) A method for providing offers of an item constituting a good or a service to users of a system, utilizing an electronic communications device, comprising at least the following:

15 establishing a communication via the electronic communications device between a given user and the system at least to initiate a primary transaction for a first good or service,

obtaining primary transaction data with respect to the primary transaction, including a purpose of the primary transaction,

20 utilizing at least in part the primary transaction data including the purpose of the primary transaction and determining at least one item for offer to the given user, and

offering the item to the given user.

230. (withdrawn) The method of claim 229 wherein the purpose of the primary transaction is a purchase transaction.

25 231. (withdrawn) The method of claim 229 wherein the purpose of the primary transaction is an informational inquiry.

232. (withdrawn) The method of claim 229 wherein the purpose of the primary transaction is a service transaction.

233. (withdrawn) The method of claim 229 wherein the purpose of the primary transaction is a sale transaction.

234. (withdrawn) The method of claim 229 wherein the purpose of the primary transaction is an inventory check.

5 235. (withdrawn) The method of claim 229 wherein the purpose of the primary transaction is a status inquiry.

236. (withdrawn) The method of claim 229 wherein the purpose of the primary transaction is an order fulfillment inquiry.

10 237. (withdrawn) The method of claim 229 wherein the purpose of the primary transaction is a comparison shopping inquiry.

238. (withdrawn) The method of claim 229 wherein the purpose of the primary transaction is a credit check.

239. (withdrawn) The method of claim 229 wherein offering the item includes offering the item to the user in real time with the primary transaction.

15 240. (withdrawn) A method for providing offers of an item constituting a good or a service to users of a system, utilizing an electronic communications device, comprising at least the following:

20 establishing a communication via the electronic communications device between a given user and the system at least to initiate a primary transaction for a first good or service,

 obtaining primary transaction data with respect to the primary transaction, including a purpose of the primary transaction,

 obtaining geographic information,

25 utilizing at least in part the primary transaction data including the purpose of the primary transaction and the geographic information, and determining at least one item for offer to the given user, and

 offering the item to the given user.

241. (withdrawn) The method of claim 240 wherein the geographic information is provided automatically.

242. (withdrawn) The method of claim 240 wherein the geographic information is provided by a carrier associated with the electronic communications device.

5 243. (withdrawn) The method of claim 240 wherein the geographic information is entered by the given user.

244. (withdrawn) The method of claim 240 wherein offering the item includes offering the item to the given user in real time with the primary transaction.

10 245. (withdrawn) A method for providing offers of an item constituting a good or a service to users of a system, utilizing an electronic communications device, comprising at least the following:

 establishing a communication via the electronic communications device between a given user and the system to at least initiate a primary transaction for a first good or service,

15 obtaining primary transaction data with respect to the primary transaction, including a purpose of the primary transaction,

 obtaining the identity of the good or service comprising the primary transaction,

20 utilizing at least in part the primary transaction data including the purpose of the primary transaction and the identity of the good or service of the primary transaction, and determining at least one item for offer to the given user, and

 offering the item to the given user.

246. (withdrawn) The method of claim 245 wherein the given user initiates a primary transaction with the system.

25 247. (withdrawn) The method of claim 245 wherein the good or service constituting the primary transaction is utilized in determining the offer for the given user.

248. (withdrawn) The method of claim 245 wherein the primary transaction is identified by answers to questions from the system.

249. (withdrawn) The method of claim 245 wherein offering the item includes offering the item to the given user in real time with the primary transaction.

250. (withdrawn) A method for providing offers of an item constituting a good or a service to users of a system, utilizing an electronic communications device, comprising at least
5 the following:

establishing a communication via the electronic communications device
between a given user and the system to at least initiate a primary transaction for a
first good or service,

obtaining primary transaction data with respect to the primary transaction,
10 including a purpose of the primary transaction,

obtaining the time,

utilizing at least in part the primary transaction data including the purpose
of the primary transaction and the time, and determining at least one item for offer
to the given user, and

15 offering the item to the given user.

251. (withdrawn) The method of claim 250 wherein the time is the time of day.

252. (withdrawn) The method of claim 250 wherein the time is the day of the week.

253. (withdrawn) The method of claim 250 wherein the time is the day of the month.

254. (withdrawn) The method of claim 250 wherein a factor in determining the good or
20 service to be offered is proximity to a calendar event.

255. (withdrawn) The method of claim 254 wherein the calendar event is user defined.

256. (withdrawn) The method of claim 250 wherein offering the item includes offering
the item to the given user in real time with the primary transaction.

257. (withdrawn) A method for providing offers of an item constituting a good or a
25 service to users of a system, utilizing an electronic communications device, comprising at least
the following:

establishing a communication via the electronic communications device between a given user and the system to at least initiate a primary transaction for a first good or service,

obtaining primary transaction data with respect to the primary transaction,
5 including a purpose of the primary transaction,

utilizing at least in part the primary transaction data including the purpose of the primary transaction, and determining at least one item for offer to the given user and determining a mode of presentation for the given user, and

offering the item to the given user.

10 258. (withdrawn) The method of claim 257 wherein the offer is made orally to the given user.

259. (withdrawn) The method of claim 257 wherein the offer is made visually to the given user.

260. (withdrawn) The method of claim 259 wherein the visual offer is static.

15 261. (withdrawn) The method of claim 259 wherein the visual offer is dynamic.

262. (withdrawn) The method of claim 257 wherein the visual offer includes a virtual reality display.

263. (withdrawn) The method of claim 257 wherein offering the item includes offering the item to the given user in real time with the primary transaction.

20 264. (withdrawn) The method of claim 220, wherein offering the item to the given user includes offering the item to the given user in lieu of the first good or service.

265. (withdrawn) The method of claim 229, wherein offering the item to the given user includes offering the item to the given user in lieu of the first good or service.

25 266. (withdrawn) The method of claim 240, wherein offering the item to the given user includes offering the item to the given user in lieu of the first good or service.

267. (withdrawn) The method of claim 245, wherein offering the item to the given user includes offering the item to the given user in lieu of the first good or service.

268. (withdrawn) The method of claim 250, wherein offering the item to the given user includes offering the item to the given user in lieu of the first good or service.

269. (withdrawn) The method of claim 257, wherein offering the item to the given user includes offering the item to the given user in lieu of the first good or service.

5 270. (withdrawn) Apparatus for providing offers of an item constituting a good or a service to users of a system, utilizing an electronic communications device, the apparatus comprising at least the following:

10 means for establishing a communication via the electronic communications device between a given user and the system at least to initiate a primary transaction for a first good or service,

 means for obtaining primary transaction data with respect to the primary transaction, including a purpose of the primary transaction,

15 means for utilizing at least in part the primary transaction data including the purpose of the primary transaction and determining at least one item for offer to the given user, and

 means for offering the item to the given user.

271. (withdrawn) The apparatus of claim 270, wherein the means for offering the item are adapted to offer the item to the given user in real time with the primary transaction.

20 272. (withdrawn) The apparatus of claim 270, wherein the means for offering the item are adapted to offer the item to the given user in lieu of the primary transaction.

Conclusion

For the foregoing reasons, the appellants submit that the rejections of the above claims should be reconsidered and withdrawn. Favorable action is requested at the Office's earliest convenience.

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Respectfully submitted,

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